

## **REMARKS**

### **Summary of the Examiner's Actions**

The examiner deemed the restriction requirement to be proper despite Assignee's traverse and made the restriction requirement final. Claims 1-13 and 17-28 were withdrawn from consideration.

The examiner rejected Claims 14-17 under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. It is assumed that the examiner intended to reject Claims 14-16. Assignee acknowledges the rejection under 35 U.S.C. § 101.

The examiner rejected Claims 14-17 under 35 U.S.C. § 112, first paragraph as being unsupported by either a specific asserted utility or a well established utility. Assignee acknowledges the rejection under 35 U.S.C. § 102(b).

The examiner rejected Claims 14-17 under 35 U.S.C. § 102(b) as being anticipated by Duncan, et al., U.S. Patent Number 6,170,439 ("Duncan, et al."). Assignee acknowledges the rejection under 35 U.S.C. § 102(b).

### **Interview Summary**

The examiner was agreeable to a personal interview with Assignee's representatives an interview on April 11, 2006. The examiner's courtesy was greatly appreciated. During the interview, the restriction requirement and the Beauregard claim style were discussed. The rejection under 35 U.S.C. § 101 and the associated rejection under 35 U.S.C. § 101, first paragraph were addressed and the examiner agreed to reconsider the rejections.

### Rejections under 35 U.S.C. § 101

The examiner rejected Claims 14-17 under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. Assignee believes that the examiner intended to reject Claims 14-16 and responds accordingly. In the rejection, the examiner states that:

Claims 14-17 [sic] are lacking any structural limitation regarding an apparatus. The preamble of claim 14 appears to be directed to a product claim (as discussed by the Assignee in the response to the restriction requirement) however, the body of the claim is directed to process steps which provide no defining limitations to a product claim. Further, claim 15-16 include a preamble directed to a process claim depending from what appears to be an apparatus claim which thereby also do not provide my structural limitation for which the Assignee can seek a patent. As there is a lack of any structure, the invention lacks patentable utility.

Assignee has previously indicated that Claim 14 is intended to be read as a product claim under *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). The examiner's current position that Claim 14 lacks patentable utility stems from the lack of structural limitations.

### *Beauregard Claims*

A copy of the decision *In re Beauregard* is attached. Beauregard appealed the decision of the Board of Patent Appeals and Interferences to the United States Court of Appeals for the Federal Circuit. *In re Beauregard*, 53 F.3d at 1584. The Board had rejected computer program product claims on the basis of the printed matter doctrine. *Id.* The Commissioner of Patents and Trademarks agreed with Beauregard that the printed matter doctrine was not applicable and moved to dismiss the case. *Id.* The Federal Circuit quoted the Commissioner's statement "that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." *Id.* Thus, since 1995, it has been the position of the U.S. Patent and Trademark Office that

computer program product claims are patentable subject matter and are considered product claims.

*Application to Claims 14-16*

By way of example, Assignee directs the examiner to Claim 10 of the Beauregard patent, U.S. Patent Number 5,710,578. Claim 10 recites:

A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for filling a polygon having a boundary definable by a plurality of lines displayed on a graphics display of said machine, said method steps comprising:

testing the polygon ...;

sequentially traversing first the boundary of the polygon ...;

generating a first array...;

generating a second array...;

combining said first array and said second array into one array ...;

and

passing a pointer to said one array...

*U.S. Pat. No. 5,710,578*, Claim 10 (Jan. 20, 1998). A review of Beauregard Claim 10 shows a preamble reciting a tangible medium ("A program storage device readable by a machine") storing a computer program ("tangibly embodying a program of instructions executable by a machine") that performs a method ("to perform method steps for filling a polygon having a boundary definable by a plurality of lines displayed on a graphics display of said machine") followed by a transition indicating that the steps of the method follow ("said method steps comprising:"). The preamble indicates that the claimed subject matter is a product. The limitations of the claim are the steps of the method performed by the computer program *product*.

In the present application, Claim 14 reads as follows:

In an apparatus for training an animal in which audible and variable level electrical stimulation is applied to the animal, a memory medium

comprising software programmed to provide for controlling the stimulation applied to the animal by a process comprising:

a) receiving an electronic signal representing a request message to stimulate the animal, said request message including an identification code and a stimulation level code;

b) determining whether an electrical stimulation is to be generated to stimulate the animal;

c) generating a first control signal corresponding to said stimulation level code; and

d) outputting said control signal to produce a signal having a voltage corresponding to said stimulation level code.

The preamble of Claim 14 recites a tangible medium ("a memory medium") storing a computer program ("comprising computer software") that performs a method ("programmed to provide for controlling the stimulation applied to the animal") followed by a transition indicating that the steps of the method follow ("by a process comprising;"). Thus, Claim 14 follows the format of a claim deemed to be statutory subject matter since 1995.

Assignee respectfully submits that claims in the form approved by *Beauregard* have well-established utility as recognized by the Commissioner of Patent and Trademarks. Assignee respectfully requests that the examiner withdraw the rejection of Claims 14-16 under 35 U.S.C. § 101.

Finally, if the examiner is of the opinion that the preamble of Claims 15 and 16 depending from Claim 14 should be reworded, Assignee is willing to consider any changes that the examiner might suggest.

#### **Rejections under 35 U.S.C. § 112, first paragraph**

The examiner rejected Claims 14-17 (again, believe to be 14-16) under 35 U.S.C. § 112, first paragraph, because without a specific asserted utility or a well-established

utility, one skilled in the art clearly would not know how to use the claim invention. For the reasons set forth with respect to the rejection under 35 U.S.C. § 101, Assignee respectfully submits that utility has been established and requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

### **Rejections under 35 U.S.C. § 102(b)**

Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

The examiner rejected Claims 14-16 under 35 U.S.C. § 102(b) as being anticipated by Duncan stating:

Duncan discloses an apparatus for training an animal with an audible and electrical stimulation inclusive of a transmitter and a receiver whereby a signal is variable to produce a variable stimulus. Reference discussions in prior office action and above in paragraph 4.

*Paper No. 20060110*, pg. 5. In paragraph 4, the examiner stated:

The Assignee has stated that the Duncan (US 6,170,439) reference does not disclose the processor producing a signal that varies the voltage to produce the desired stimulation level. This is respectfully disagreed with. As can be seen in the Abstract of the patent, Duncan discloses a signal that "causes the amplitude of the voltage pulses produced...to be representative of the selected stimulus level". As such, it is maintained that the variation in amplitude of voltage pulses as disclosed by Duncan to control the selected stimulus level anticipate the limitation regarding a

signal that varies the voltage to produced [sic] the desired stimulation level. The rejection is maintained.

*Id.* at 3.

#### *Duncan, Generally*

Duncan discloses a remote controlled animal training system. Specifically, Duncan discloses two embodiments: a training only collar that issues a shock stimulus (Fig. 2) and a combination training and locator collar that issues a shock stimulus for training and provides an audible locator beacon (Fig. 3).

The basic training collar disclosed by Duncan receives a signal transmitted from the transmitter 11. *Duncan*, Fig. 2, 3. The transmitter allows selection of one of six desired electrode stimulus signal levels. *Duncan*, col. 4, ln. 55-57. The stimulus level is encoded into the transmitted signal. *Id.* at ln. 58-60. The receiver decodes the stimulus level and a microprocessor produces a stimulation level selection signal. *Id.* at ln. 60-67. The stimulus level selection signal causes the stimulus generation circuitry to produce an electrical stimulus with the desired intensity. *Id.* at col. 5, ln. 4-19. More specifically, the stimulus level selection signal results in the production of a drive signal "consisting of drive pulses the widths of which are determined by which of the six available stimulus level selection signals 23 is applied to pulse generator circuit 24." *Id.* at ln. 4-11.

The locator collar disclosed by Duncan adds a beeper unit that produces an audible sound allowing the trainer to determine if the dog is moving or is motionless. *Id.* at ln. 20-33. The transmitter allows the beeper location function to be turned off and on. *Id.* at ln. 29-33. The beeper locator wirelessly communicates with the training collar. *Id.* at col. 7, ln. 57 to col. 8, ln. 34. Basically, the training collar produces a signal that activates a secondary transmitter 49 that activates and deactivates the beeper locator.

*Id.* at col. 7, ln. 57 to col. 8, ln. 4. The training collar and the beeper locator are a matched pair and the signal that is transmitted by the secondary transmitter is an address code. *Id.* at col. 8, ln. 5-6. Receipt of a matching address by the beeper locator toggles the on/off state of the beeper locator. *Id.* at ln. 6-9.

#### *Claims 14-16*

Claim 14 of the present application includes the step of "receiving an electronic signal representing a request message to stimulate the animal, said request message including an identification code and a stimulation level code." The identification code and the stimulation level code are detailed in paragraph 14 of the present application. Duncan discloses that the "stimulus level selected is digitally encoded into an rf signal 8 that is transmitted by an antenna 14 on transmitter 11 to the antenna 16 and detected by an FM receiver 15." *Duncan*, col. 4, ln. 58-60. Duncan does not disclose encoding any other information, and specifically does not disclose encoding an identification code, into the transmitted signal used for the training function. Therefore Duncan lacks at least one limitation expressly required by Claim 14.

Assignee notes that Duncan does disclose sending a coded address signal between the training collar and the beeper locator. As with the signal generated by the primary transmitter, the encoded signal contains only one piece of information. It carries only an address and no stimulation level information. Thus, Duncan still does not anticipate all of the limitations of Claim 14.

Claim 14 of the present application also includes the steps of "generating a first control signal corresponding to said stimulation level code" and "outputting said control signal to produce a signal having a voltage corresponding to said stimulation level code." As discussed above, the drive signal (i.e., the control signal) has a pulse width corresponding to the stimulus level selection signal (i.e., the stimulation level

code). Duncan does not disclose varying the voltage of the drive signal in response to the stimulus level selection signal.

The examiner's reference to the Abstract refers to the voltage of the stimulus actually applied to the animal varying with the stimulus level selection signal and quotes a portion of a sentence. The complete sentence states that the

second stream of pulses is applied to the control electrode of a switch coupled in series with a primary winding of an output transformer of the receiver *to repetitively turn the switch on for durations equal to the width of the pulse of the second stream and causes the amplitude of the voltages pulses produced between contact electrodes connected to terminals of the secondary winding of the output transformer to be representative of the selected stimulus level.*

*Duncan*, Abstract (emphasis added). When considered in context, it is clear that it is the width of the second stream of pulses (i.e., the drive signal) that controls the voltage of the stimulus. Thus, Duncan does not disclose the limitation of Claim 14.

In view of the fact that Duncan fails to disclose one or more limitations expressly required by Claim 14, Assignee respectfully submits that Duncan is not a proper anticipatory reference and requests that the examiner withdraw the rejection of Claim 14 and Claims 15 and 16 depending therefrom under 35 U.S.C. § 102(b).

#### *Claim 15*

Claim 15 adds the step of "verifying said coded signal from said identification code." As Duncan does not disclose an identification code, Duncan also does not disclose a verification step as required by Claim 15. Therefore, Duncan is not a proper anticipatory reference because it lacks at least one limitation expressly required by Claim 15. Assignee respectfully requests that the examiner withdraw the rejection of Claim 15 under 35 U.S.C. § 102(b).



### *Claim 16*

Claim 16 adds the step of "determining whether a beep is to be generated to stimulate the animal." As previously noted, the beeping function disclosed by Duncan is for the purpose of locating the animal and not for training. Duncan does not disclose any mechanism generating a beep for stimulating the animal. Therefore Duncan is not a proper anticipatory reference because it lacks at least one limitation expressly required by Claim 16. Assignee respectfully requests that the examiner withdraw the rejection of Claim 16 under 35 U.S.C. § 102(b).

### **Miscellaneous Amendments**

Claim 16 has been amended to correct the punctuation ending the claim.

### **New Claims**

Claims 29-31, also Beauregard claims, have been added for consideration by the examiner. Assignee respectfully submits that the new claims are adequately supported by the original disclosure, contain no new matter, and do not require restriction from Claims 14-16 previously elected.

### **Final Restriction Requirement**

The examiner maintained and made final the restriction requirement. Assignee likewise maintains the objection to the restriction requirement, but in order to facilitate examination, Assignee is canceling the non-elected claims with the intent to pursue those in one or more divisional applications.

### **Summary**

In view of the cancellation of Claims 1-13 and Claims 17-28, the amendment of Claim 16, the addition of Claims 29-31, and the arguments presented herein, it is

believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the examiner is respectfully requested. If, however, the examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

Respectfully submitted,

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## Briefs and Other Related Documents

## ON MOTION

United States Court of Appeals, Federal Circuit,  
 In re Gary M. BEAUREGARD, Larry K. Loucks,  
 Khoa Dang Nguyen and Robert J. Urquhart,  
**No. 95-1054.**

## ORDER

May 12, 1995.

Appeal was taken from order of the Board of Patent Appeals and Interferences rejecting computer program product claims on basis of printed matter doctrine. On Commissioner's motion to dismiss appeal, the Court of Appeals, Archer, Chief Judge, held that appeal did not present case or controversy, where parties agreed that printed matter doctrine did not apply to computer program product claims.

Vacated and remanded.

West Headnotes

**Patents 291** **324.2**

291 Patents

291XII Infringement

291XII(C) Suits in Equity

291k324 Appeal

291k324.2 k. Decisions Reviewable.

Most Cited Cases

Appeal from decision of the Board of Patent Appeals and Interferences, rejecting computer program product claims on basis of printed matter doctrine, did not present case or controversy, where parties agreed that printed matter doctrine did not apply, and Commissioner of Patents and Trademarks stated that computer programs embodied in tangible medium, such as floppy diskettes, were patentable. 35 U.S.C.A. § § 101-103.

\*1583 Nancy J. Linck, Sol., Albin F. Drost, Deputy Sol. and Richard Torezon, Associate Sol., Office of the Sol., Arlington, VA, were on the Com'r of Patents and Trademarks motion to dismiss for lack of jurisdiction.

Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, Washington, DC, was on Appellants' response to the Com'r's motion to dismiss for lack of jurisdiction.

ARCHER, Chief Judge.

The Commissioner of Patents and Trademarks moves to dismiss Gary M. Beauregard \*1584 et al.'s appeal. Beauregard responds stating that vacatur or reversal of the Board of Patent Appeals and Interferences' decision and remand to the Board is the appropriate disposition. Beauregard requests that the remand order be issued as a precedential order.

Briefly, on August 4, 1994, the Board rejected Beauregard's computer program product claims on the basis of the printed matter doctrine. Beauregard appealed. The Commissioner now states "that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. § § 102 and 103." The Commissioner states that he agrees with Beauregard's position on appeal that the printed matter doctrine is not applicable. Thus, the parties are in agreement that no case or controversy presently exists.

Accordingly,

IT IS ORDERED THAT:

The Board's decision is vacated and the case is remanded for further proceedings in accordance with the Commissioner's concessions.

C.A.Fed., 1995.

In re Beauregard

53 F.3d 1583, 35 U.S.P.Q.2d 1383

Briefs and Other Related Documents ([Back to top](#))

• 1995 WL 17205110 (Appellate Brief) Brief for Appellants Gary M. Beauregard et al. (Mar. 15, 1995) Original Image of this Document with Appendix (PDF)

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